REMARKS/ARGUMENTS

The office action of October 18, 2005 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-13 and 15-28 remain in this application. Claim 14 was previously canceled without prejudice or disclaimer.

On page 13, paragraphs 25 and 26, of the office action, claim 14 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of references. Since claim 14 was previously canceled in the last amendment filed July 12, 2005, which amendment was entered in the record by the RCE filed August 3, 2005, the rejection of claim 14 is moot.

Claims 1-12 and 23-28 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The action alleges that the claimed feature of "rescaling said drawing in accordance with said axes and proportion[al] to the modification in line size" is not described to convey that applicants had the invention including this feature in their possession at the time of filing. Applicants respectfully disagree. Paragraphs [39] and [40] of applicants' specification describe rescaling as claimed.

Claims 1, 6-8, 12, 16, 19 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 5,091,964 to Shimomura in view of U.S. patent no. 6,115,501 to Chun et al. ("Chun"). Claims 13, 15 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,397,233 to Okawa et al. ("Okawa") and further in view of U.S. patent no. 5,712,995 to Cohn. Claims 2-3, 9-11, 24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun as applied to claims 1, 6-8, 12, 16, 19 and 23 above, and further in view of U.S. patent no. 5,867,593 to Fukuda et al. ("Fukuda"). Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun as applied to claims 1, 6-8, 12, 16, 19 and 23 above, Fukuda as applied to claims 2-3, 9-11, 24 and 26 above, and further in view of U.S. patent no. 6,326,970 to Mott et al. ("Mott"). Claims 17-18 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun as applied to claims 1, 6-8, 12, 16-19 and 23 above, and further in view of

Mott. Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and further in view of U.S. patent no. 6,075,532 to Colleran et al. ("Colleran"). Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun and further in view of Colleran. Applicants respectfully traverse all these rejections.

Claims 1-12, 16-19 and 23-27

Claims 1, 6-8, 12, 16, 19 and 23

Amended claim 1 recites, among other features, rescaling the drawings in accordance with the axes and proportional to the modification in line size of a text portion. The action alleges that Shimomura discloses rescaling the drawings in accordance with the modification in line size pointing to col. 2, lines 5-31 and col. 5, line 45 to col. 6, line 23 and the disclosure of "reducing or scaling down each of the plurality of image regions divided." In addition in responding to arguments presented in the applicants' last response, the action contends that "Shimomura discloses the sizes of the blocks ... are reduced so that a circumscribed rectangular frame in the block is reduced, and the same processing of forming a new circumscribed rectangular frame (line size) is applied to each of the blocks to redefine its size (col. 4, line 10 – col. 6, line 61 and Fig. 2)." In sum, the action contends that the circumscribed rectangular frame of each block shows the line size as claimed. To clarify claim 1 further, applicants have specified that the request received is to modify a line size *of a text portion* of the document. As the circumscribed rectangular frame of each block in Shimomura is not a text portion of a document, Shimomura does not teach or suggest receiving a request to modify a line size *of a text portion* of the document and rescaling the drawings in accordance with the axes and *proportional* to the modification *in line size of a text portion* as recited in claim 1.

The action acknowledges that Shimomura does not teach or suggest rescaling the drawings in accordance with the axes. To remedy this defect, the action relies on the Abstract and col. 24, lines 41-45 of Chun. Notwithstanding whether Chun suggests rescaling the drawings in accordance with the axes, Chun lacks a teaching or suggestion of rescaling the drawings

proportional to the modification in line size *of a text portion* as recited in claim 1. Chun is directed to a grid moving method for minimizing image information of an object image and a compression/motion estimation method using the gird moving method. Generally, the method is directed to separating and coding information in regions of the grid to reduce the memory requirements for storing the image data and the amount of time to transmit the data when the image is reformed. Consequently, the combination of Shimomura and Chun, even if proper, does not result in the claim 1 invention including at least rescaling the drawings *proportional* to the modification in line size *of a text portion.*

For at least the above reason, claim 1 is patentably distinct from Shimomura and Chun. Claims 6-8 and 12, which depend from claim 1, are considered allowable over Shimomura and Chun for the same reason, and further in view of the additional advantageous features recited therein.

Amended independent claim 23 is similar to claim 1 in the distinguishing respects noted above, and for at least these reasons is patentable over the combination of Shimomura and Chun.

Amended independent claim 16 recites, among other features, in response to a change in a line size of *a text portion* of the document, rescaling each of the drawings *proportional* to the change in the line size of *the text portion*, and in accordance with the distance to the one of the reference axes. As generally discussed with respect to claim 1, the combination of Shimomura and Chun lacks a teaching or suggestion of rescaling each of the drawings *proportional* to the change in the line size of *the text portion* as recited in claim 16. For at least this reason, claim 16 and claim 19, which depends from claim 16, are patentably distinct from the combination of Shimomura and Chun.

Claims 2-5, 9-11, 24 and 26

Claims 2-3, 9-11, 24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun as applied to claims 1, 6-8, 12, 16, 19 and 23 above, and further in view of Fukuda. Claims 2, 3 and 9-11 ultimately depend from claim 1 and claims 24 and 26 ultimately depend from claim 23. Applicants submit that Fukuda fails to remedy the defects of Shimomura and Chun discussed above with respect to claims 1 and 23. For at least this

reason, the combination of Shimomura, Chun and Fukuda does not result in the inventions of claims 2-3, 9-11, 24 and 26.

Applicants submit that one skilled in the art would not have modified Shimomura and Chun with Fukuda to obtain the invention of claims 2, 3, 9-11, 24 and 26. In the last response applicants provided reasons as to why one skilled in the art would not have been motivated to combine Fukuda and Shimomura; those reasons apply to combining Fukuda with Shimomura and Chun and are herein incorporated by reference. In response to those arguments, the action merely reasserts the same motivation set forth in the last action, "[b]y repositioning or re-dividing the regions so [the] overlapping problem would not exist [sic] ... would enhance the image region dividing system." The action has failed to address the valid reasons set forth by applicants why one skilled in the art would not have combined the references in the manner alleged. Notably, there is no evidence that overlapping can even occur or is even a concern with the system of Shimomura. As such, there clearly is no incentive or motivation to modify Shimomura and Chun with Fukuda to obtain the invention of claims 2, 3, 9-11, 24 and 26. Any such modification would be tantamount to engaging in impermissible hindsight reconstruction.

Similarly, claims 4 and 5, which depend from claim 3, are patentably distinct over the combination of Shimomura, Chun, Fukuda and Mott for at least this reason and further in view of the discussion below regarding the lack of motivation to combine Mott with Shimomura and Chun.

Claims 17, 18 and 25

Claims 17, 18 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun as applied to claims 1, 6-8, 12, 16-19 and 23 above, and further in view of Mott. Claims 17 and 18 ultimately depend from claim 16 and claim 25 ultimately depends from claim 23. Applicants submit that Mott fails to remedy the defects of Shimomura and Chun discussed above with respect to claims 16 and 23. For at least this reason, the combination of Shimomura, Chun and Mott does not result in the inventions of claims 17, 18 and 25.

Applicants submit that one skilled in the art would not have modified Shimomura and Chun with Mott to obtain the invention of claims 17, 18 and 25. In the last response applicants

provided reasons as to why one skilled in the art would not have been motivated to combine Mott and Shimomura; those reasons apply to combining Mott with Shimomura and Chun and are herein incorporated by reference. Responding to those arguments, the action asserts that "[s]ince both Shimomura and Mott disclose modify[ing] images, they are analogous arts, and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Shimomura and Mott." Assuming that Shimomura and Mott are from analogous arts does not alone make their combination appropriate; some motivation or incentive to modify Shimomura and Chun with Mott must exist. Applicants have provided valid reasons why one skilled in the art would not have been motivated to combine the reference, and the action has failed to address these reasons. For at least those same reasons, combining Mott with Shimomura and Chun would have been improper, and any such modification would be tantamount to engaging in impermissible hindsight reconstruction.

Claim 27

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and Chun and further in view of Colleran. Applicants submit that Colleran fails to remedy the defects of Shimomura and Chun discussed above with respect to claim 23 from which claim 27 depends. For at least this reason, the combination of Shimomura, Chun and Colleran does not result in the invention of claim 27.

Applicants submit that one skilled in the art would not have modified Shimomura and Chun with Colleran to obtain the claim 27 invention. In the last response, applicants submitted that one skilled in the art would not have modified Shimomura with Colleran to realize the claim 27 invention for some of the same reasons set forth with respect to modifying Shimomura with Fukuda. Applicants submit that the same reasons set forth with respect to modifying Shimomura and Chun with Fukuda apply to modifying Shimomura and Chun with Colleran. For example, the action has failed to show that overlapping can even occur, or is much less a concern, with the system of Shimomura. As such, one skilled in the art would not have had any incentive or motivation to modify Shimomura and Chun with Colleran to obtain the claim 27 invention.

Claims 20-22

Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura and further in view of Colleran. The action continues to allege that Shimomura shows the step of dividing, but acknowledges that Shimomura fails to provide a teaching or suggestion of determining a bounding box, identifying an anchor point, and storing and offset value. In an attempt to remedy these defects, the action relies on Fig. 4, and col. 8, line 46 to col. 9, line 52 of Colleran. The action alleges that it would have been obvious to combine Shimomura with Colleran, because "Colleran's system improves the efficiency of redrawing animated characters on a desktop."

In the last two responses, applicants asserted that one skilled in the art would not have modified Shimomura with Colleran. In response, the action merely reiterated the same rationale for combining the references without specifically addressing the points raised by applicants. Applicants will re-present those points below and should these positions be maintained in the next action, applicants respectfully request that the next action directly address the substantial issues identified below.

The focus of Shimomura involves automatically extracting text regions from a document image containing mixed forms of text, drawings and pictures. In addition, the primary object of Shimomura, ("detecting more precisely the existence of a blank portion or an unfilled pixel region as a boundary between adjacent text images" col. 1, lines 42-45) does not even remotely suggest adding a new drawing. Notably, Shimomura is directed to extracting a text region of a document and performs the step of dividing documents into adjacent regions during this process. As such, the skilled artisan with Shimomura in hand would not have cared whether the system of Colleran improves the efficiency of redrawing animated characters on a desktop as that was wholly unrelated to the purpose of Shimomura. The combination of Shimomura and Colleran amounts to nothing more than an exercise in impermissible hindsight. As such, one skilled in the art would not have been motivated to combine Shimomura and Colleran to obtain the claim 20

invention. For at least this reason, claim 20 and its dependent claims, 21 and 22, are considered patentable over the applied art.

Claims 13, 15 and 28

Claims 13, 15 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okawa and further in view of Cohn. The action alleges that Okawa discloses all the steps of independent claim 13, but for determining whether the rescaled drawings overlap one another, and if so, repositioning one or more of the drawings to avoid the overlap. To overcome this deficiency, the action relies on Cohn pointing to col. 2, lines 27-54.

Cohn relates to the management of window type user interfaces, and discloses that when an individual window is resized or repositioned, neighboring windows can be resized and repositioned to avoid overlap of windows. As such, Cohn describes repositioning windows on a computer desktop to avoid overlapping windows. In applying Cohn, the action asserts that resizing and repositioning windows to avoid overlap is equivalent to or in some way suggests repositioning drawings to avoid overlap. Applicants respectfully disagree. The claim 13 invention is directed to a method for editing *an electronic document containing text and drawings*. A window corresponds to an instance of an application and resizing a window, such as one corresponding to a word processing document merely resizes and repositions the user interface as opposed to resizing or repositioning the content in the underlying document. Stated differently, resizing or repositioning a window does not teach or suggest, and is wholly unrelated and not analogous to repositioning one or more drawings in a document to avoid overlap. Also, Cohn resizes and repositions neighboring windows in response to an individual window being resized as opposed to plural windows being resized. Consequently, in contrast to the action's assertion, it would not have been inherent for Cohn to determine whether rescaled *windows* overlap one another as only an individual window has been resized prior to repositioning the neighboring windows to avoid overlap. For at least the above reasons, the combination of Okawa and Cohn would not have resulted in the invention of claim 13 or dependent claims 15 and 28.

Moreover, one skilled in the art would not have looked to combine Okawa and Cohn as Cohn is non-analogous art.

CONCLUSION

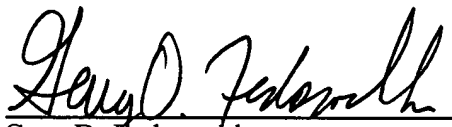
It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: January 11, 2006

By: 

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